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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/812,996

03/31/2004

Wah Yiu Kwong

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EXAMINER

MA, CALVIN

ART UNIT

PAPER NUMBER

2609

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/812,996	<b>Applicant(s)</b> KWONG, WAH YIU	
	<b>Examiner</b> Calvin Ma	<b>Art Unit</b> 2609	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03/31/2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03/31/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Priority*

1. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/536714, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for claims 14-25 of this application. The "multimedia entertainment center" disclosure in the current specification is not present in the provisional application 60/536714.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 12, 14-16, 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Henty (U.S. Patent 6,094,156).

As to claim 1, Henty (Fig 1) discloses a pointing device (top side of 10), comprising: a first surface (top surface 10) including an interface (12) to control a multimedia entertainment center (PC/TV entertainment system) (see column 1 line 59-62) having a personal computer (218) and a display (TV monitor 222); and a second surface (i.e. surface which is inner side of 10), opposite said first surface, including an input device (60) to remotely move a pointer (24) on the display (see column 3, line 48 - column 4, line 20).

Claim 14 is analyzed as previously discussed with respect to claim 1 above because it substantially recites the same limitations as claim 1.

As to claim 2, Henty teaches the pointing device according to claim 1, further comprising first and second select buttons (62, 64) coupled to the input device (see Fig 2A).

As to claim 3, Henty teaches the pointing device according to claim 1, wherein the input device comprises a touch pad (60) (see column 4, lines 10-14).

As to claim 12, Henty teaches the pointing device according to claim 1, wherein the input device and the select buttons are coupled to the personal computer (218) by a wireless interface (36) (see column 4, lines 25-26) (see Fig 10).

Claims 15, 16 are analyzed as previously discussed with respect to claim 2 and 3, respectively because they recite the same limitations.

As to claim 24, Henty teaches the multimedia entertainment center according to claim 14, further comprising a switch (106) to selectively control operations on the first surface and the second surface (see column 5, lines 25-33).

As to claim 25, Henty teaches the multimedia entertainment center according to claim 14, further comprising a wireless keyboard (see Fig 6A, 6B, 6C) having a cradle formed (124) to cradle the pointing device (122) and enable the input device to remotely move the pointer on the display (222) (i.e. the retractable pointing device goes into body of the keyboard which serves as a cradle).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4, 6-7, 13, 17, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henty in view of Derocher (U.S.P.G. Pub 2004/0027341).

As to claim 4, Henty teaches the pointing device in claim 3, but does not teach wherein the touch pad comprises a capacitive-sensing touch pad. Derocher teaches wherein the touch pad (7) comprises a capacitive-sensing touch pad (see [0042]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the touch pad mechanism of Derocher inside the remote control system of Henty to enable, "feedback that is responsive to the user input and provide the user the ability to intuitively determine the mode of operation of the touch pad." (see Derocher [0004]).

As to claim 6, Derocher teaches the pointing device according to claim 4 wherein the capacitive-sensing touch pad (7) further comprises a second simulator interface to simulate scrolling (see [0033]).

As to claims 7 and 20, Derocher teaches the pointing device according to claim 4, wherein the capacitive-sensing touch pad (7) comprises a transparent capacitive-sensing touch pad (see [0028]).

As to claim 13, Derocher the pointing device according to claim 12, wherein the wireless interface comprises a Bluetooth interface (see [0026]).

Claims 17 and 19 are analyzed as previously discussed with respect to claim 4 and 6, respectively because they recite the same limitations.

6. Claims 5, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henty in view of Derocher (U.S.P.G. Pub 2004/0027341) as applied to claims 4, 6-7, 13, 17, 19-20 above, and further in view of Anderson (U.S. Patent 6,424,338).

As to claim 5, note the discussion of Henty and Derocher above, Derocher teaches the capacitive-sensing touch pad, but does not teach that it further comprises a

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first simulator interface to simulate mouse clicks. Anderson teaches a first simulator interface to simulate mouse clicks (see column 5, lines 36-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the mouse click functionality of Anderson inside the remote control of Henty as modified by Derocher to enable, "intuitive" functionality which allows a user to choose the control gain configuration in a manner that is more direct and intuitive than conventional touch pad (see Anderson column 2, line 7).

Claim 18, is analyzed as previously disclosed with respect to claim 5 because it recites the same limitations.

7. Claims 8-11, 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henty in view of Derocher as applied to claims 4, 6-7, and 17, 19-20 above, and further in view of Trent and et al. (U.S.P.G. Pub 2004/0252109).

As to claim 8, note the discussion of Henty and Derocher above, Henty teaches the pointing device according to claim 2, further comprising a multi-directional controller (24) on the first surface to remotely move the pointer on the display (222), but does not mention a pointing stick. Trent teaches a pointing stick for moving the pointer (see [0025]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the pointing stick structure and the control system

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of Trent in place of the multi-directional controller of Henty as modified by Derocher because Trent's pointing stick would provide the cursor moving indefinitely without being picked up and repositioned as a conventional input (see [0002] of Trent).

As to claim 9, Trent teaches the pointing device according to claim 8, further comprising an interlock (i.e. the system is able to extract which sensor is being used and use this information to reject simultaneous input on multiple sensors) (see [0114]) to cooperatively control inputs from the pointing stick (24) (see [0025]) on the first surface and the input device (26) (see figure 2) on the second surface.

. As to claim 10, Henty teaches the pointing device (24) according to claim 8, wherein the input device and the select buttons (62, 64) are coupled to the personal computer by a wireless interface (36) (see column 4, lines 25-26) (see Fig 10).

Claims 11, and 21-23 are analyzed as previously disclosed with respect to claim 8, 10, 11, 13, respectively because they recite the same limitations.

### ***Conclusion***

McLoone (U.S.P.G. Pub 2005/0025549) is cited to teach a similar control system with multiple interactive control devices.

### ***Inquiry***


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Calvin Ma whose telephone number is (571)270-1713. The examiner can normally be reached on Monday - Friday 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chanh Nguyen can be reached on (571)272-7772. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Calvin Ma  
March 15, 2007

  
CHANH D. NGUYEN  
SUPERVISORY PATENT EXAMINER

